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| 09/396,407      | 09/15/1999  | DAVID H. KOIZUMI     | 2207/6657           | 7402             |

7590 08/02/2004  
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EXAMINER

AZARIAN, SEYED H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2625

DATE MAILED: 08/02/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/396,407

Applicant(s)

KOIZUMI, DAVID H.

Examiner

Seyed Azarian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-23 is/are allowed.
- 6) ☒ Claim(s) 1-6, 17, 18, 24-26 is/are rejected.
- 7) ☒ Claim(s) 7-16, 19 and 27-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **RESPONSE TO AMENDMENT**

1. Applicant's arguments, filed 5/13/2004, see page 1, with respect to the rejection of claims 1-30 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Lemelson (U.S. patent 5,563,401), Milford (U.S. patent 4,922,086), Shimoma et al (JP 56162689), Beery (U.S. patent 4,087,789) and Taguchi et al (U.S. patent 5,215,397).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C 112:

The specification shall contain a written disclosure of the invention, and the manner and process of making an using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

Claims 1-5 are single means claims or at least depend from a single means claim. Claim 1 is merely an apparatus, and claim 5 is merely a storage structure comprising a surface. Accordingly, these claims are of undue breadth. In re Hyatt, 708

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F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property result) while the specification discloses at most only those known to the inventor.

### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemelson (U.S. 5,563,401).

For claim 1, an apparatus for storage of information comprising magnetic ink, including a magnetic substance, the magnetic ink having a stored information signal is provided by Lemelson in at least (column 2, lines 25-30), where code information is explicitly recited, and in the last full paragraph in column 2, where such information codes can be in the form of magnetic ink.

Additionally for claim 1, the Manual of Patenting Examining Procedure (MPEP) clearly points out that apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). Furthermore, the manner of operating the device does not differentiate apparatus claims from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Thus, the apparatus for storage of information comprising magnetic ink of claim 1 is not distinguishable from the prior art of Lemelson.

For claim 2, the magnetic ink of claim 1, wherein the stored information signal includes an analog information signal is provided by Lemelson in (column 1, lines 37-43).

For claim 3, the magnetic ink of claim 1, wherein the stored information signal includes a digital information signal is provided by Lemelson in (column 1, lines 37-43).

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For claim 5, see the rejection of at least claim 1 where cited above in Lemelson in at least (column 2, lines 25-30), and the last full paragraph in column 2. Furthermore, like claim 1 above, a magnetic information storage structure comprising magnetic ink applied to a surface as claimed in claim 5 is also not structurally distinguishable from Lemelson where cited above.

6. Claims 24-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Milford, (U.S.4,922,086).

For claim 24, a method of storing information comprising applying magnetic ink on a surface is provided by Milford in at least the first full paragraph in column 7, where a document has magnetic ink printed thereon, and applying a varying magnetic flux to the magnetic ink is provided by Milford also in the first full paragraph in column 7, where the magnetic flux density clearly varies.

Regarding claim 25, Milford discloses the method of claim 24, wherein the information is digital information signal (Fig. 1, column 3, lines 35-50).

Regarding claim 26, the arguments analogous to those presented for claim above are applicable.

### **Claim Rejections - 35 USC § 103**

7. Following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4, is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson (U.S. 5,563,401) in view of Taguchi et al (U.S. 5,215,397).

Regarding claim 4, Lemelson fails to disclose, "signal includes a time varying frequency signal". On the other hand Taguchi et al in the same filed of magnetic ink teaches handwriting storing section and the distance moved by the writing device can be detected based on a continuing time period of a predetermined combination of the signals output (column 5, lines 31-56).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lemelson invention according to the teaching of Taguchi because by providing range of frequency of timing signal that can be based on the characteristics of the magnetic ink, which can easily be implemented in an magnetic ink device such as magnetic pen.

9. Claims 6, 17 and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoma et al (JP56162689), in view of beery (U.S. patent 4,087,789).

For claim 6, a penpoint adapted to apply magnetic ink to a surface is considered provided by the writing instrument of Shimoma in the abstract by at least a tip end and/or a stylus, which applies magnetic ink to a surface to be recorded. A magnetic ink write head, coupled to the penpoint and adapted to apply a magnetic flux as it is applied by the penpoint to the surface is provided by Shimoma in at least the abstract and Fig. 1 by at least a magnetism source. Shimoma clearly provides for the application of a

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magnetic flux, but not explicitly for a varying magnetic flux. The application of a varying magnetic flux in printing magnetic ink is conventional and well known and is provided by Beery in at least the fourth full paragraph in c. 1 and in the last full paragraph in c. 2, as is standard practice. Shimoma and Beery are in the same field of printing magnetic ink and Shimoma can clearly use a varying magnetic flux in the writing process as taught by Beery. It would've been obvious to one having ordinary skill in the art at the time the invention was made to use a varying magnetic flux as taught by Beery with the magnetic writing of Shimoma, since using a varying magnetic flux is conventional and well known, and because Beery provides for at least the advantage of magnetizing a surface that is independent of irregularities or non-uniformities, and that segments are magnetized uniformly without phase offset or frequency variations.

Regarding claims 17 and 18, the arguments analogous to those presented for claims above are applicable.

### ***Allowable Subject Matter***

10. Claims 7-16, 19 and 27-30, are objected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.



***Allowable Subject Matter***

11. Claims 20-23 are allowed.

**Contact Information**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Azarian whose telephone number is (703) 306-5907. The examiner can normally be reached on Monday through Thursday from 6:00 a.m. to 7:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached at (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Status information about the PAIR system, see [http:// pair-direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Seyed Azarian  
Patent Examiner  
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July 20, 2004



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